

Attorney Docket No. P11006

REMARKS/ARGUMENTS**1.) Claim Amendments**

The Applicant has amended claim 4 to correct a minor grammatical oversight and has canceled claims 1-3 without prejudice. Claims 5 and 6 were previously canceled. Thus, claim 4 is pending in this application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections – Claims 1 through 3:

The Examiner rejected claims 1-3 under 35 U.S.C. § 101, 112, and 103 as being unpatentable for a variety of new "grounds." Solely in order to ready this application for appeal, the Applicant has canceled claims 1 through 3 without prejudice. Consequently, the rejections and objections regarding claims 1 through 3 are deemed to be moot.

3.) Claim Rejections – Claim 4:

The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over McLain, Jr. (US 5,956,513); Leblang, et al. (US 5,574,898); and Albrecht et. al. (US 5,950,011); and further in view of Hammond (US 5,974,470) and Luu (US 5,860,012). The Applicant respectfully traverses this rejection.

McLain discloses an improved tool for managing the software build process by automatically identifying the header, include and other shared library files.

Leblang discloses an auditor for recording, as an audit record, which versions of objects are accessed by a processor during a data processing process (as opposed to a build process).

Albrecht discloses an editor which uses information in a knowledge base related to the topography of a network and configuration parameters of various elements which comprise the network to construct a configurable homogenous entity which can be loaded into station to be configured in which the interpreter executes a configuration operation to transform the configuration parameters into the desired configuration for that particular station.

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Hammond relates to a system for managing DLL modules and providing administrators (as opposed to programmers) of Windows based personal computers with more control over Windows modules.

Luu discloses a technique to allow a LAN administrator (as opposed to a programmer) to install application software on a user's workstation without the user's intervention.

Assuming *arguendo*, that the combination discloses all the elements of claim 4, it is respectfully submitted that the combination of McLain, Leblang, Albrecht, Hammond and Luu is improper. According to MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Since the Federal Circuit first addressed this issue in *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984), the Federal Circuit has consistently held that:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ***Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.***

ACS Hosp. Systems, Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)); *In re Fritch*, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992).

Also, the case law is clear that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations.* Rather,

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particular findings must be made as to the reason the skilled artisan, *with no knowledge of the claimed invention*, would have selected these components for combination in the manner claimed. *Ecolocem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000). Here, no such evidence has been presented. In addition, there is absolutely no teaching, suggestion or motivation to support the combination of McLain, Leblang, Albrecht, Hammond and Luu.

The current case law makes it clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *In re Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without **evidence** of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* ***It is respectfully submitted that the only way McLain, Leblang, Albrecht, Hammond and Luu could be pieced together to defeat patentability is indeed to use Applicant's disclosure as a blueprint.*** Therefore, the combination of references is improper.

The current standard for obviousness is stated below:

Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the tempting but forbidden zone of hindsight, . . . when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then accepted wisdom in the field. . . . Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. . . . In this case, the Board fell into the hindsight trap. . . . The range of sources available, however, ***does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.***

In re Dembiczak, 50 USPQ 2d 1614, 1616-17 (Fed. Cir. 1999) (quotations omitted)

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It is respectfully submitted that there is no evidence presented by the Examiner for the motivation which would lead one skilled in the art to combine the references.

The Examiner states:

The reason and motivation for this is that these path and version data would be the uppermost piece of information to parse in the source code in order to have immediate and a starting point to retrieve instructions to retrieve linking files, system configuration and dynamic libraries as intended by McLain, Leblang or Albrecht, especially when the build process resulting package is distributed to the user in a heterogeneous network as suggested by Albrecht or wherein the need for an administrator can be obviated according to Luu (col. 1, lines 51-56); and that resolving incompatibilities from reading global variables packaged in an installation executable can alleviate further resources in small recipient systems where execution resources are limited.

First, the Applicant is somewhat confused by the above statement and cannot follow its logic. Second, the Applicant respectfully questions whether this "motivation" cannot be found in the cited references or in the relevant art. In fact, this reason is so detailed and convoluted that it can only be derived from the Applicant's application itself – providing additional support for the fact that the Examiner is using the Applicant's Application as a blueprint to pick and choose features from the five references to arrive at claim 4. Finally, the Applicant respectfully states that reason given above is not the clear and particular "evidence" demanded by the Federal Circuit under the current standard. Thus, under the current standard set by the Federal Circuit, the Examiner has not made a prima facie case for obviousness.

In the present case, it is apparent from a reading of McLain, Leblang, Albrecht, Hammond and Luu that none of five these references recognized the problem of tracking software path and version number with said executable software in such a manner that said path and version number is retrievable at the site. Thus, this is a classic example of a solution to a problem being obvious only after recognition of the problem by the applicant and is part of the "subject matter as a whole" language of 35 USC § 103 which should always be considered in determining the obviousness of an invention under this statute.

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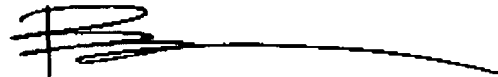
Thus, for this independent reason, the examiner's burden of factually supporting a prima facie case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

CONCLUSION

In view of the foregoing remarks, the Applicant believes the currently pending claim in the Application is in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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Date: September 7, 2004

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